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09/345,448	07/01/1999	DOUGLAS WALTER CONMY		1268

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EXAMINER

LY, ANH

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 08/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/345,448

Applicant(s)

CONMY ET AL.

Examiner

Anh Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 11-19 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-19 and 21-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. Claim 36 has been added.
2. Claims 1-4, 6-9, 11-19 and 21-36 are pending in this application.

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-4, 6-9, 11-19 and 21-36 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 6, 11, 16 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,119,101 issued to Peckover.

With respect to claim 1, Peckover discloses one non-web document from at least one database (product database see fig. 2, item 32, is a non-web document), the subscription requesting means comprising a selection formula, wherein the selection formula is programmed with search criteria corresponding to the subscription (see figs. 40 and 41: searching criteria is displayed from which the user can select the optional displayed on the screen, and all selection options are programmed in the background), wherein the search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention (the result is displayed to the user: 19, lines 18-25; and magazine subscription lists is display: col. 3, lines 14-20 and col. 30, lines 35-50); subscription parameter receiving means for receiving at least one subscription parameter from the user wherein the at least one subscription parameter indicates a type of information to retrieve (searching the magazine subscription: col. 3, lines 14-20; and col. 19, lines 15-25); search performing means for performing a search of the at least one database for information matching the subscription; subscription retrieving means for retrieving the information matching the subscription (search result is listed: col. 19, lines 15-25); and subscription notification

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means for notifying the user of matched and retrieved information (response manager is issued a notification to the user: col. 30, lines 25-32).

Peckover does not clearly disclose non-web document and selection formula.

Peckover discloses a product database for user to search the desired items with criteria displayed in the fig. 40 and fig. 41. All these options are programmed in the application before displayed to the user to select items to be searched.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the product database as a non-web document and selection screen displayed as in fig. 40 and 41 for searching with the criteria and the search result would delivered periodically according to the customer/subscriber's desired period (col. 30, lines 35-50) for the user enabling to subscribe and update information via a network environment.

With respect to claim 6, Peckover discloses one non-web document from at least one database (product database see fig. 2, item 32, is a non-web document); a selection formula (see figs. 40 and 41: searching criteria is displayed from which the user can select the optional displayed on the screen, and all selection options are programmed in the background), and presented to the user at various intervals without additional user intervention (the result is displayed to the user: 19, lines 18-25; and magazine subscription lists is display: col. 3, lines 14-20 and col. 30, lines 35-50); subscription parameter receiving means for receiving at least one subscription parameter from the user wherein the at least one subscription parameter indicates a type of information to retrieve; search performing means for performing a search of the

at least one database for information matching the subscription; subscription retrieving means for retrieving the information matching the subscription; and subscription notification means for notifying the user of matched and retrieved information (searching the magazine subscription: col. 3, lines 14-20; and col. 19, lines 15-25; search result is listed: col. 19, lines 15-25; response manager is issued a notification to the user: col. 30, lines 25-32).

Peckover does not clearly disclose non-web document and selection formula. Peckover discloses a product database for user to search the desired items with criteria displayed in the fig. 40 and fig. 41. All these options are programmed in the application before displayed to the user to select items to be searched.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the product database as a non-web document and selection screen displayed as in fig. 40 and 41 for searching with the criteria and the search result would delivered periodically according to the customer/subscriber's desired period (col. 30, lines 35-50) for the user enabling to subscribe and update information via a network environment.

Claim 11 is essentially the same as claim 1 except that it is directed to a method rather than a system (product database see fig. 2, item 32, is a non-web document, see figs. 40 and 41: searching criteria is displayed from which the user can select the optional displayed on the screen, and all selection options are programmed in the background, the result is displayed to the user: 19, lines 18-25; and magazine subscription lists is display: col. 3, lines 14-20 and col. 30, lines 35-50; searching the

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magazine subscription: col. 3, lines 14-20; and col. 19, lines 15-25; search result is listed: col. 19, lines 15-25; and response manager is issued a notification to the user: col. 30, lines 25-32), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 16 is essentially the same as claim 1 except that it is directed to a processor readable medium rather than a system (product database see fig. 2, item 32, is a non-web document, see figs. 40 and 41: searching criteria is displayed from which the user can select the optional displayed on the screen, and all selection options are programmed in the background, the result is displayed to the user: 19, lines 18-25; and magazine subscription lists is display: col. 3, lines 14-20 and col. 30, lines 35-50; searching the magazine subscription: col. 3, lines 14-20; and col. 19, lines 15-25; search result is listed: col. 19, lines 15-25; and response manager is issued a notification to the user: col. 30, lines 25-32), and is rejected for the same reason as applied to the claim 1 hereinabove.

With respect to claims 33-35, Schwartz discloses syntax checking means for determining whether code input in the programmed selection formula is correct (figs. 40-41); further comprising subscription disabling means for temporarily discontinuing the subscription for a predetermined period of time (col. 30, lines 38-45); and wherein the search criteria corresponding to the subscription is an electronic mail message containing a predetermined text (delivering e-mail: col. 5, lines 40-45)..

With respect to claim 36, Peckover discloses enabling a user to input search criteria specifying the information to which the user want to subscriber, said search

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criteria including a search formula; performing a search in the plurality of databases to identify the information corresponding to said search criteria and said search formulas, wherein said search is performed periodically and automatically without additional user's input; retrieving said identified information and presenting said retrieved information to the user (see figs. 40 and 41: searching criteria is displayed from which the user can select the optional displayed on the screen as programmed formulas, and all selection options are programmed in the background, the result is displayed to the user: 19, lines 18-25; and magazine subscription lists is display: col. 3, lines 14-20 and col. 30, lines 35-50; searching the magazine subscription: col. 3, lines 14-20; and col. 19, lines 15-25; search result is listed: col. 19, lines 15-25; and response manager is issued a notification to the user: col. 30, lines 25-32).

Peckover does not clearly disclose non-web document, and selection formula. Peckover discloses a product database for user to search the desired items with criteria displayed in the fig. 40 and fig. 41. All these options are programmed in the application before displayed to the user to select items to be searched.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the product database as a non-web document and selection screen displayed as in fig. 40 and 41 for searching with the criteria and the search result would delivered periodically according to the customer/subscriber's desired period (col. 30, lines 35-50) for the user enabling to subscribe and update information via a network environment.



7. Claims 2-3, 7-8, 14-15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,119,101 issued to Peckover in view of US Patent No. 6,141,653 issued to Conklin et al. (hereinafter Conklin).

With respect to claims 2-3, 7-8, Peckover discloses a system as discussed in claims 1 and 6.

Peckover does not disclose explicitly indicate, "the search of the at least one database on a random basis."

However, Conklin discloses the search of the at least one database on a random basis as claimed (col. 29, lines 12-47).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Peckover with the teachings of Conklin so as to have the search performing means that performs the search of at least one database on a random basis because the combination would provide an information system with any of multiple electronic information objects such as, e-mail, web page, or non-web document for mass distributing to the requested subscriber.

Claim 14 is essentially the same as claim 2 except that it is directed to a method rather than a system (col. 29, lines 12-47), and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 15 is essentially the same as claim 3 except that it is directed to a method rather than a system (col. 29, lines 12-47), and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 17 is essentially the same as claim 2 except that it is directed to a medium rather than a system (col. 29, lines 12-47), and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 18 is essentially the same as claim 3 except that it is directed to a medium rather than a system (col. 29, lines 12-47), and is rejected for the same reason as applied to the claim 3 hereinabove.

8. Claims 4, 9, 12-13, 19, and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,119,101 issued to Peckover in view of US Patent No. 6,020,980 issued to Freeman.

With respect to claims 4 and 9, Peckover discloses a system as discussed in claims 1 and 6.

Peckover does not disclose explicitly indicate, "the input means for enabling a user to input one or more options relating to the subscription."

However, Freeman discloses the input as claimed (col. 10, lines 38-54).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Peckover with the teachings of Freeman so as to have the search performing means that performs the search of at least one database on a random basis because the combination would provide an information system with any of multiple electronic information objects such as, e-mail, web page, or non-web document for mass distributing to the requested subscriber.

With respect to claim 12, Peckover discloses a system as discussed in claim 11.

Peckover does not disclose explicitly indicate, "subscription presenting means for presenting the subscription to the user."

However, Freeman discloses the subscription presenting means as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Peckover with the teachings of Freeman so as to have the search performing means that performs the search of at least one database on a random basis because the combination would provide an information system with any of multiple electronic information objects such as, e-mail, web page, or non-web document for mass distributing to the requested subscriber.

With respect to claim 13, Peckover discloses the step of periodically searching the at least one database (product database: fig. 2 item 32 and col. 30, lines 35-50).

Claim 19 is essentially the same as claim 4 except that it is directed to a medium rather than a system (col. 10, 38-54), and is rejected for the same reason as applied to the claim 4 hereinabove.

With respect to claim 21, Peckover discloses a system as discussed in claim 1.

Peckover does not disclose explicitly indicate, "at least one database is a Lotus Notes database."

However, Freeman discloses the Lotus Notes as claimed (col. 4, lines 36-67, and col. 5, lines 1-6).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Peckover with the teachings of Freeman so as to have the search performing means that performs the search of at least one database on a random basis because the combination would provide an information system with any of multiple electronic information objects such as, e-mail, web page, or non-web document for mass distributing to the requested subscriber.

With respect to claim 22, Peckover discloses a system as discussed in claim 1.

Peckover does not disclose explicitly indicate, "subscription presenting means for presenting the subscription to the user."

However, Freeman discloses the subscription presenting means as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Peckover with the teachings of Freeman so as to have the search performing means that performs the search of at least one database on a random basis because the combination would provide an information system with any of multiple electronic information objects such as, e-mail, web page, or non-web document for mass distributing to the requested subscriber.

With respect to claim 23, Peckover discloses a system as discussed in claim 1.

Peckover does not disclose explicitly indicate, "subscription presenting means presents the subscription as an electronic mail message."

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However, Freeman discloses the email message as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Peckover with the teachings of Freeman so as to have the search performing means that performs the search of at least one database on a random basis because the combination would provide an information system with any of multiple electronic information objects such as, e-mail, web page, or non-web document for mass distributing to the requested subscriber.

With respect to claim 24, Peckover discloses a system as discussed in claim 6.

Peckover does not disclose explicitly indicate, "at least one database is a Lotus Notes database."

However, Freeman discloses the Lotus Notes as claimed (col. 4, lines 36-67, and col. 5, lines 1-6).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Peckover with the teachings of Freeman so as to have the search performing means that performs the search of at least one database on a random basis because the combination would provide an information system with any of multiple electronic information objects such as, e-mail, web page, or non-web document for mass distributing to the requested subscriber.

With respect to claim 25, Peckover discloses a system as discussed in claim 6.

Peckover does not disclose explicitly indicate, "subscription presenting means for presenting the subscription to the user."

However, Freeman discloses the subscription presenting means as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Peckover with the teachings of Freeman so as to have the search performing means that performs the search of at least one database on a random basis because the combination would provide an information system with any of multiple electronic information objects such as, e-mail, web page, or non-web document for mass distributing to the requested subscriber.

With respect to claim 26, Peckover discloses a system as discussed in claim 6.

Peckover does not disclose explicitly indicate, "subscription presenting means presents the subscription as an electronic mail message."

However, Freeman discloses the email message as claimed (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Peckover with the teachings of Freeman so as to have the search performing means that performs the search of at least one database on a random basis because the combination would provide an information system with any of multiple electronic information objects such

as, e-mail, web page, or non-web document for mass distributing to the requested subscriber.

Claim 27 is essentially the same as claim 21 except that it is directed to a method rather than a system (col. 4, lines 36-67, and col. 5, lines 1-6), and is rejected for the same reason as applied to the claim 21 hereinabove.

Claim 28 is essentially the same as claim 22 except that it is directed to a method rather than a system (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56), and is rejected for the same reason as applied to the claim 22 hereinabove.

Claim 29 is essentially the same as claim 23 except that it is directed to a method rather than a system (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56), and is rejected for the same reason as applied to the claim 23 hereinabove.

Claim 30 is essentially the same as claim 21 except that it is directed to a medium rather than a system (col. 4, lines 36-67, and col. 5, lines 1-6), and is rejected for the same reason as applied to the claim 21 hereinabove.

Claim 31 is essentially the same as claim 22 except that it is directed to a medium rather than a system (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56), and is rejected for the same reason as applied to the claim 22 hereinabove.

Claim 32 is essentially the same as claim 23 except that it is directed to a medium rather than a system (see abstract, col. 6, lines 19-49, and col. 7, lines 28-56), and is rejected for the same reason as applied to the claim 23 hereinabove.

**Contact Information**

9. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527 or via E-Mail: **ANH.LY@USPTO.GOV**. The examiner can be reached on Monday – Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Kim Vu, can be reached on (703) 305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231


or faxed to: (703) 746-7238 (After Final Communication)


or (703) 746-7239 (for formal communications intended for entry)

or: (703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

AL   
Aug. 5<sup>th</sup>, 2003

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
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